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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/783,379	02/19/2004	William S. Hurst	TR-6009	6415

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EXAMINER
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SCHATZ, CHRISTOPHER

ART UNIT	PAPER NUMBER
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1733

DATE MAILED: 06/15/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/783,379

Applicant(s)

HURST ET AL.

Examiner

Christopher T. Schatz

Art Unit

1733

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 26 March 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-76 is/are pending in the application.
- 4a) Of the above claim(s) See Continuation Sheet is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3, 5, 11-13, 15, 21-23, 25-28, 30, 35, 37-39, 41, 42, 44-51 and 56-58 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 February 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>5/24/04, 11/9/05</u> | 6) <input type="checkbox"/> Other: _____  |

**Continuation of Disposition of Claims: Claims withdrawn from consideration are 4,6-10,14,16-20,24,29,31-34,36,40,43,52-55 and 59-76.**

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Applicant's election with traverse of the elected species in the reply filed on March 23, 2006 is acknowledged. The traversal is on the ground(s) that each of the independent claims of Group I are connected in design, operation, and effect. This is not found persuasive. Applicant should note that examiner is not restricting the independent claims of Group I, but rather the dependent claims. Applicant never presents any reasons as to why the embodiments of the restricted dependent claims are not mutually exclusive. Furthermore, even if all of the claims are connected in design operation, and effect, said claims can still be mutually exclusive. It should be noted that claim 23 has been rejoined with claim 22 because the two species are considered to be obvious over each other. See Section 8 below. Claims 4, 6, 7-10, 14, 16-20, 24, 29, 31-34, 36, 40, 43, 52-55, and 59-76 are withdrawn as being drawn to a non elected invention.

The requirement is still deemed proper and is therefore made FINAL.

### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1, 5, 11, and 15 are rejected under 35 U.S.C. 102(e) as being anticipated by Flanagan (2003/0141002).

Flanagan discloses a method for assembling a medical device comprising: providing a first article of a polymeric material 20; providing a second article of a polymeric material 22; contacting and attaching the first article with the second article along an interface area 24; and exposing the first article and the second article to a specific portion of the infrared spectrum where the polymeric material of the first article and the polymeric material of the second article absorb infrared energy in order to generate sufficient heat to create a bond between the first article and the second article (paragraphs 0033-0037, figures 1 and 2).

As to claims 5 and 15, Flanagan discloses a method wherein the first article is a medical tubing and the second article is a medical tubing (paragraph 0036, figure 6).

4. Claims 1, 2, 5, 11, 12, and 15 are rejected under 35 U.S.C. 102(b) as being anticipated by Peters et al. '552.

Peters et al. discloses a method for assembling a medical device comprising: providing a first article of a polymeric material; providing a second article of a polymeric material; contacting and attaching the first article with the second article along an interface area; and exposing the first article and the second article to a specific portion of the infrared spectrum where the polymeric material of the first article and the polymeric material of the second article absorb infrared energy in order to generate sufficient heat to create a bond between the first article and the second article (figure 5a-5f, column 8, lines 6-56).

As to claims 2 and 12, Peters et al. discloses a method further comprising the step of providing a shield which fits over a portion of the interface area, said shield allowing infrared

Art Unit: 1733

exposure to reach the interface area while protecting a non-bonding area (column 2, 64-67, column 8, lines 44-48). As to claims 5 and 15, Peters et al. discloses a method wherein the first article is a medical tubing and the second article is a medical tubing (column 8, lines 9-11).

5. Claims 1, 5, 11, 15, 21, 26-28, 30, 35, 41, 45-47, and 51 are rejected under 35

U.S.C. 102(e) as being anticipated by Holman et al. (2003/0201059).

Holman et al. discloses a method for assembling a medical device comprising: providing a first article of a polymeric material; providing a second article of a polymeric material; contacting and attaching the first article 12 with the second article 16 along an interface area; and exposing the first article and the second article to a specific portion of the infrared spectrum where the polymeric material of the first article and the polymeric material of the second article absorb infrared energy in order to generate sufficient heat to create a bond between the first article and the second article (paragraph 0034-0039).

As to claims 5, 15, 30, and 42 Holman et al. discloses a method wherein the first article is a medical tubing and the second article is a medical tubing (paragraph 0034, 0068). As to claims 21 and 41, Holman et al. discloses a method for assembling a medical device comprising the steps of: providing a first article 12 of a polymeric material; providing a second article 16 of a polymeric material; applying an infrared absorbing pigment to the first article and the second article to define an interface area (paragraph 0039); contacting the first article with the second article along the interface area; and bonding the first article to the second article along the interface area using infrared exposure (paragraph 0034-0039). As to claims 26-28 and 45-47, Holman et al. discloses a method wherein the infrared absorbing pigment is placed on a first portion of the first or second article in a first concentration and in a second portion of the surface

Art Unit: 1733

in a second concentration lower than the first concentration; applying a first infrared exposure to the first portion of the surface to create a seal, and applying a second infrared exposure higher than then the first infrared exposure to the second portion of the surface to create a second seal (paragraphs 0058-0067, 0034-0045, 0013-0018, figure 14). As to claim 51, Holman et al. discloses a method for assembling a medical device, said method comprising: providing a first article 12 of a polymeric material; providing a second article 16 of a polymeric material; providing an infrared responsive pigmented film 18; placing the infrared responsive pigmented film between the first article and the second article to define an interface area and contacting the first article with the second article; and applying infrared exposure to bond the first article and the second article (figures paragraph 0034-0039).

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-3, 5, 11-13, 15, 21, 25-28, 30, 35, 37, 38, 41, 42, 44-51, and 56-58 are rejected under 35 U.S.C. 103(a) as being unpatentable over Peters et al. '552 in view of Holman et al. (2003/0201059).

Peters et al. discloses a method for assembling a medical device comprising the steps of: providing a first article of a polymeric material; providing a second article of a polymeric

Art Unit: 1733

material; contacting the first article with the second article along the interface area; and bonding the first article to the second article along the interface area using infrared exposure (figure 5a-5f, column 8, lines 6-56).

Peters et al. is silent as to a method of applying an infrared absorbing pigment to the first and second articles. Holman et al. discloses a method of assembling two medical tubular articles together as discussed above, and further discloses a step of applying an infrared absorbing pigment to the first article and the second article to define an interface area (paragraph 0037-0039). Holman et al. also discloses that an infrared responsive pigmented film 18 can be placed between the first article and second article to define an interface area (paragraph 0039).

Application of said pigment coating or film provides each article with a desired absorption characteristic (paragraph 0035-0037). At the time of the invention it would have been obvious to a person of ordinary skill in the art to modify the method of Peters et al. by applying an infrared absorbing pigment (as a coating or film) to the first article and the second article to define an interface area as taught by Holman et al. above. Such a modification would enable the absorption characteristics of the articles of Peters et al. to be varied to a desired characteristic.

As to claims 25 and 44, examiner asserts that printing is a well-known method of coating an article, and one of ordinary skill in the art would have readily appreciated printing the coating onto the first and second articles. As to claims 26-28, 30, 42 and 45-47, Holman et al. meets the limitations of said claims as discussed above. As to claims 35, 48, and 56 Peters et al. meets the limitations of said claims for the reasons set forth in the discussion of claims 2 and 12 above. As to claims 3, 13, 37, 49, and 57 examiner asserts that PTFE is a well-known material in the art, and one of ordinary skill in the art would have readily recognized its use as an infrared blocker.



Art Unit: 1733

As to claims 38, 50, 51 Peters et al. discloses that bonding takes place as a result of infrared absorption at multiple locations along an axis (locations 40, 41, 38, 39). Since the reference discloses that the heat shield blocks non-bonding regions from infrared exposure, the presence of “slots” at locations 40, 41, 38, 39, is inherent to the heat shield of Peters et al. because said locations are exposed to infrared light.

8. Claims 21-23 and 39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Holman et al. as applied above, and in further view of Ammann et al. ‘097.

Holman et al. discloses a method as discussed above, and further discloses that any known infrared absorbing pigment can be used. The reference is silent however, as to specifically using carbon black or activated charcoal. Ammann et al. discloses a method for assembling a medical device comprising: providing first and second articles of polymeric material, contacting the first article with the second article along the interface area and bonding the two articles together using infrared radiation (figure 2, column 2, line 40 – column 4, line 8). Ammann further discloses that it is well known and preferable to use carbon black or activated charcoal as the infrared absorbing pigments at the bonding interface (column 3, lines 5-10). At the time of the invention it would have been obvious to a person of ordinary skill in the art to use either carbon black or activated charcoal as the applied infrared absorbing pigment as is well known in the art and taught by Ammann et al.

As to claim 39, Ammann et al. discloses a method wherein bonding is performed using an infrared lamp (column 3, line 63 – column 4, line 7).

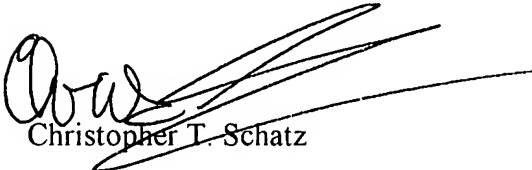
Art Unit: 1733

*Conclusion*

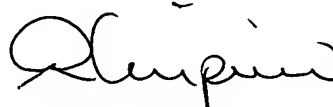
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher T. Schatz whose telephone number is 571-272-1456. The examiner can normally be reached on 8:00-5:30, Monday -Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Crispino can be reached on 571-272-1226. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



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